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Simon Thomas Lewis

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EXAMINER

GITLIN, MATTHEW J

ART UNIT

PAPER NUMBER

3635

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/594,350 | Applicant(s) LEWIS ET AL. | |
| | Examiner Matthew J. Gitlin | Art Unit 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/26/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The preliminary amendment filed 09/26/2009 has been entered. Claim 35 has been cancelled. Claims 1-34 and 36 remain pending.

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 5, 7, 12, 15, 19-21, 25 and 30** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 12, 19 and 25, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

5. Regarding claims 5, 7, 15 and 30 the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-5, 7, 11, 13-14, 18, 23, 27-28, 32, 34, and 36** are rejected under 35

U.S.C. 102(b) as being anticipated by Crofoot (US 3,894,368).

8. **Claims 1, 23, 34 and 36;** Crofoot discloses a building structure (**Fig 6**), a joist holder (**1**) including a preformed sleeve (**Body as shown in Fig. 1**) of water-impermeable material (**Column 1, Lines 10-15**) for receiving one end of a joist (**Fig. 8**), the sleeve being mountable on a wall (**Fig. 7**).

The method steps of Claim 23 are deemed inherent to the structural as disclosed by Crofoot in Claim 1.

9. **Claim 2;** Crofoot discloses wherein one end of the sleeve is closed by a base portion (**Right end Fig. 2**) so that the holder forms a box with one open end (**Left end Fig. 2**).

10. **Claim 3;** Crofoot discloses a flange (**2a, 2b, or 2c**) that extends transversely from one or more edges of the open end of the sleeve (**Fig. 1**).

11. **Claim 4;** Crofoot discloses the flange abuts the surface (**Fig. 6**) of the wall into which the joist is inserted.

12. **Claim 5;** Crofoot discloses wherein the flange includes one or more apertures (**Formed by Nails 6 in Fig. 6**) for screws or the like.

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13. **Claim 7;** Crofoot discloses wherein an outer surface of the sleeve includes external ribs (5) in order to improve adhesion to cement or the like (**As seen in Figs. 7 and 8**).
14. **Claim 11;** Crofoot discloses wherein the joist holder is formed of plastic (**Column 1, Lines 10-15**).
15. **Claim 13;** Crofoot discloses wherein the depth of the sleeve corresponds to the depth of a standard building block or brick (**Item 11, Figs. 7 and 8**).
16. **Claim 14;** Crofoot discloses an extension of an end wall of the sleeve (**Lower portion of end wall in Fig. 1, being a separate extension of wall sleeve**).
17. **Claim 18;** Crofoot discloses wherein the holder is coated with, fire and/or smoke and/or fume resistant material. (**Figs 6-8, coated with concrete which is inherently resistant to fire**).
18. **Claim 27;** Crofoot discloses placing wall building material (7) around an or on top of the mounted sleeve.
19. **Claim 28;** Crofoot discloses further securing the sleeve to the wall by inserting screws (6) through a flange (2a, 2b, 2c) extending around one end of the sleeve (**Fig. 1**) to fix the sleeve to the wall.
20. **Claim 32;** Crofoot discloses a building structure (**Fig. 6**) including joists mounted by means of a joist holder according to claim 1 (**See rejection to Claim 1**).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claim 6, 8-10, 12, 15-17, 19-21, 24-26, 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Crofoot (US 3,894,368).

23. **Claim 6;** Crofoot does not expressly disclose wherein the width of the flange is around 25 to 75 millimeters.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the flange of Crofoot having a width around 25-75 milimeters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

In re Aller, 105 USPQ 233.

24. **Claim 8;** Crofoot discloses the external ribs are arranged perpendicular to external surface of the sleeve (**Fig. 1**) but does not expressly disclose wherein the protrusions comprise a plurality of diagonal lines extending across the sleeve surface.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to alter the angle of the external ribs of Crofoot, to enable the ribs to lay diagonal to external surface of the sleeve, because changing the angle of construction of an element involves only routine skill in the art to adequately anchor the sleeve to a specific orientation required by engineering design choice.

25. **Claims 9-10;** Crofoot does not expressly disclose wherein the holder is dimensioned to substantially correspond to dimensions of standard joists or wherein the dimensions to securely

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fit around the end of 102 X 47 millimeters; 127 millimeters X 47 millimeters; 152 X 47 millimeters; 203 X 47 millimeters or 228 millimeters X 47 millimeters rectangular joist.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to fabricate the holder to fit these or any dimension of joist in order to fit a specific application based on engineering design choice to support any load of an increased size based on a need for a larger or smaller joist as needed.

26. ***Claim 12;*** Crofoot does not expressly disclose wherein the surfaces of the holder are coated with a material such as rubber to provide increased friction.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to provide a coating of a material to provide increased friction, on the surfaces of the holder of Crofoot, in order to provide an increase in holding of the sleeve in order to allow the holder to securely anchor a beam or joist in a wall so it can securely support a load imposed upon it.

27. ***Claims 15, 19-21;*** Crofoot does not expressly disclose one or more apertures to allow screws or the like to fix the underside of a joist to the extension in use, wherein at least one sidewall of the sleeve includes an aperture, in use, the aperture being used to allow a fixing device, to be inserted through the sleeve to a joist fitted in the holder, wherein the aperture is located about midway across the width of the sleeve sidewall(s), or wherein opposing said sidewalls of the sleeve each include a said aperture, one of the apertures being offset horizontally and/or vertically from the other aperture.

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At the time of the invention it would have been obvious to a person having ordinary skill in the art to provide one or more apertures to allow screws to fix the underside of a joist to the extension in use, wherein at least one sidewall of the sleeve includes an aperture, in use, the aperture being used to allow a fixing device, to be inserted through the sleeve to a joist fitted in the holder, wherein the aperture is located about midway across the width of the sleeve sidewall(s), and wherein opposing said sidewalls of the sleeve each include a said aperture, one of the apertures being offset horizontally and/or vertically from the other aperture in order to secure the joist to the sleeve further securing the joist from movement and enabling a better hold. Also, since Crofoot already discloses apertures for securing the sleeve with a fastener (**See rejection to Claim 5**) in the flange, at the time of the invention it would have been obvious to a person having ordinary skill in the art to provide these same apertures on any other part of the sleeve, in any orientation as claimed above, to increase its holding capacity so to allow the joist to securely support a load imposed upon it.

28. **Claims 16-17;** Crofoot discloses the claimed invention except for wherein the sleeve is at least partially formed of transparent or semi-transparent material and wherein at least one end wall of the sleeve includes a panel formed of transparent or semi-transparent material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the holder as wherein the sleeve is at least partially formed of transparent or semi-transparent material and wherein at least one end wall of the sleeve includes a panel formed of transparent or semi-transparent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

29. ***Claim 24 and 26;*** Crofoot does not expressly disclose wherein the inserting step takes place before the mounting step, or vice versa.

Since Crofoot discloses the adequate structure above (**As seen in the Rejection to Claim 23**), at the time of the invention it would have been obvious to a person having ordinary skill in the art to try to the inserting step before or after the mounting step, since these steps are well know and well within the scope of the skill of a person having ordinary skill in the art at the time of the invention, to perform.

30. ***Claim 25;*** Crofoot discloses inserting a fixing device through an aperture in the sleeve and into the joist, as seen in the rejection to Claims 15, 19-21, but does not expressly disclose performing the step of inserting the fixing device before the step of mounting the sleeve.

Since Crofoot discloses the adequate structure, at the time of the invention it would have been obvious to a person having ordinary skill in the art to try to the inserting step before or after the mounting step, since these steps are well know and well within the scope of the skill of a person having ordinary skill in the art at the time of the invention, to perform.

31. ***Claim 31;*** Crofoot discloses a sleeve (**1**) for a joist comprising a water impermeable preformed wall (**Rear wall of sleeve 1 as shown in Fig. 8**) for at least partially encircling an end of the joist (**Fig. 8**) for preventing water penetration to the joist end, the sleeve further including an anchor portion (**2a, 2b, 2c**) for anchoring to the face of a block work wall (**Fig. 6**), but does not expressly disclose wherein the sleeve is dimensioned to have a depth approximately equal to a standard building block.

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At the time of the invention it would have been obvious to a person having ordinary skill in the art to alter the dimensions of the sleeve of Crofoot, in order to fit a standard building block, because changing the size and dimensioning of any member is well within the ability of someone having ordinary skill in the art to perform, to fit a specific engineering design application.

32. **Claim 22, 29, 30 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Crofoot (US 3,894,368) in view of Pruett (US 5-910,085).

Crofoot discloses the a kit for mounting a joist in a wall including a holder according to Claim 3 (**As seen in the rejection to Claim 3 above**) but does not expressly disclose a substantially L-shaped bracket, in use, one portion of the bracket being fixed to the wall and another portion of the bracket being fixed to a side surface of a joist inserted into the holder.

Pruett discloses an L-shaped bracket (**10**) for securing a joist (**29**) to a structure (**28**), one portion (**12**) of the bracket being fixed to the structure (**Fig. 2**), and one portion (**11**) of the bracket being fixed to a side surface of the joist (**Fig. 2**) for the purpose of eliminating squeaking between the joist and structure.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to provide the joist holder of Crofoot, with a substantially L-shaped bracket, in use, one portion of the bracket being fixed to the wall and another portion of the bracket being fixed to a side surface of a joist inserted into the holder, as taught by Pruett, in order to provide additional holding properties of the sleeve and holder by taking stress off of the holder, as the L-shaped bracket is secured to the joist and wall structure.

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The method steps of Claim 29 are deemed inherent to the structural as disclosed by Crofoot, in view of Pruett, in Claim 22.

33. ***Claims 30 and 33;*** Crofoot discloses a building structure (**Fig. 6**), mounting a joist (**Fig. 1**) to the building structure (**Fig. 6**) including steps of: positioning a joist end into a preformed sleeve of water-impermeable material (**Fig. 8, Column 1, Lines 10-15**), but does not expressly disclose locating the sleeve in a course of building blocks or the like, wherein the steps of positioning and locating can be performed in either order.

At the time of the invention it would have been obvious to a person having ordinary skill in the art to provide the preformed sleeve of Crofoot in a course of building blocks, because it is sized and shaped to do so, and based on engineering design choice, it would have been obvious to use the joist sleeve of Crofoot, in a course of blocks for that specific application, since it is clearly capable of performing the action, in any order as claimed.

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Gitlin whose telephone number is (571)270-5525. The examiner can normally be reached on Monday - Friday (7:30am-5:00pm EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. G./
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit
3635